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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,187	03/24/2005	Mario Polegato Moretti	268435US6PCT	4422

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EXAMINER

KAVANAUGH, JOHN T

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 11/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/529,187

Applicant(s)

POLEGATO MORETTI, MARIO

Examiner

Ted Kavanaugh

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-32 is/are pending in the application.
- 4a) Of the above claim(s) 24-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-23 and 27-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3-24-2005, 7-11-2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Species II (figures 6-9) in the reply filed on Oct. 25, 2006 is acknowledged. The traversal is on the ground(s) that examiner fails to list the different groups of claims and explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group. This is not found persuasive because there is no special or corresponding technical feature inasmuch as all of the elected claims are rejected, see the rejection below. With regard to the listing of the groups; Species II claims have been examined below and Species I claims have been withdrawn.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 24-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on Oct. 25, 2006.

Claim Rejections - 35 USC § 112

3. Claims 17-23,27-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 17 and 32, the phrase "at least in a preset macroportion" and "at least one through macroperforation at said at least one preset macroportion made of net, felt

or other diffusely perforated material" is not clear or understood. It is not clear what a "preset macroportion" is.

In claim 21, a support layer having a single large macroportion" is not accurate. The support layer is 110 doesn't have any "macroportion".

Also, in claim 21, the support layer covered by "said membrane and said tread" is inaccurate inasmuch as the tread 15,115 is placed below the membrane (13,113).

In claim 23, the phrase "through the meshes of said net or of the felt" is indefinite inasmuch as the previous claims call for a "net, felt or other diffusely perforated material". The "net" and "felt" are not necessary claimed.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 17,18,20-21,23,27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 97/14326 (Polegato).

Polegato teaches a waterproof and breathable sole as claimed including a support layer (106) made out of felt, a membrane (105), a tread (103) as claimed except for the tread made out of plastic. It would have been obvious to one having ordinary skill in the art at the time the invention was made to made the tread of Polegato out of plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of

obvious design choice. *In re Leshin*, 125 USPQ 416. See figure 3, which shows each of the layers having perforations or preset macroportion's as claimed.

6. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 17 above, and further in view of US 6477789 (Cheng).

Cheng teaches providing each of the apertured layers with a mesh layer on top and/or bottom to permit air to pass through freely; see col. 3, lines 8-32. Therefore, it would have been obvious to provide the membrane as taught above with a mesh layer there above, as taught by Cheng, to permit air to pass through freely.

7. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 21 above, and further in view of US 6508015 (Rauch).

Rauch teaches a breathable sole wherein the tread (outsole) has substantially one single large through macroperforation that affects substantially all of the sole of the foot; see figures 2 and 3 which has substantially one single large opening in the bottom of the outsole to enhance breathing of the sole. It would have been obvious to provide the tread as taught above with one single large through macroperforation, as taught by Rauch, to permit the shoe to breath.

Conclusion

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

2. **Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including:**

-“The reply must present arguments pointing out the *specific* distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.”

--“A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.”

-Moreover, “The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06” MPEP 714.02. The “disclosure” includes the claims, the specification and the drawings.

3. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.


In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (571) 273-8300 **(FORMAL FAXES ONLY)**. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (571) 272-4556. The examiner can normally be reached from 6AM - 4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562.

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Ted Kavanaugh
Primary Examiner
Art Unit 3728

TK
November 13, 2006